



UNITED STATES PATENT AND TRADEMARK OFFICE

ck
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/166,701	10/05/1998	ISA ODIDI	SMI-005.01	9432

25181 7590 04/26/2007
FOLEY HOAG, LLP
PATENT GROUP, WORLD TRADE CENTER WEST
155 SEAPORT BLVD
BOSTON, MA 02110

EXAMINER

GEMBEH, SHIRLEY V

ART UNIT	PAPER NUMBER
----------	--------------

1614

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/166,701

Applicant(s)

ODIDI ET AL.

Examiner

Shirley V. Gembah

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,7-12,23 and 28-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,7-12, 23 and 28-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/16/07 has been entered.

Response to Remarks

The response filed **1/16/07** presents remarks and arguments to the office action mailed **12/16/05**. Applicants' request for reconsideration of the rejection of claims in the last office action has been considered.

Applicants' arguments, filed, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 1614

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1,4, 7-12, 23 and 28-33 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Nowhere in the specification is there a mention of 1-15% by weight of a mixture of hydroxyethyl cellulose and hydroxypropyl methylcellulose. The closest to mentioning a mixture is recited at page 5, lines 3-5, wherein blending about 1-80% of a selected pharmaceutically active agents with about 1-60 % of uncrosslinked linear polymer such as hydroxyethyl cellulose and 1-15% of another crosslinked polymer hydroxypropyl methylcellulose.

Claims 1,4, 7-12, and 30-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not support the "the amount of hydroxyethyl cellulose and hydroxypropyl methylcellulose affects the release rate of selected pharmaceutical active substances.

Double Patenting

Art Unit: 1614

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,4,7-12, 23 and 28-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 22 of U.S. Patent Application No. **11473386**. Although the conflicting claims are not identical, they are not patentably distinct from each other. The reasons are as follows:

Both sets of claims refer to a pharmaceutical compositions in the current application (claims 1,4,7-12, 23 and 28-33) and (claims 14-17) in the copending application. The copending application anticipates the claims of the instant application.

The claims of the co-pending application recite a polysaccharide and an uncrosslinked linear polymer and that of the instant claims recite using polymers of acrylic acid cross linked with polyalkenyl alcohols and hydroxyethyl cellulose which are obvious variation of the co-pending application claims. See current application claims 1,4,7-12, 23 and 28-33 and copending application claims 14-17. The compositions recited in the claims are anticipatory of each other.

Art Unit: 1614

As to the copending application claims 1-13 and 18-22, these claims refer to a device and a method of treating. The device and method of treating would have been used for the delivery of the pharmaceutical composition of claims 14-17 in the copending application. Thus, the process of making a composition and using a device are a set of precursor steps to the process of treating and therefore are part of the obvious variation of the copending application claims compared to the current application claims.

In view of the foregoing, the copending application claims and the current application claims are obvious variations.

Claims 1,4,7-12, 23 and 28-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims **1 - 28** of U.S. Patent No. **7090867**. Although the conflicting claims are not identical, they are not patentably distinct from each other. The reasons are as follows:

The claims of the patent refer to a method of making a controlled release whilst the claims of the instant application refer to a pharmaceutical composition of a controlled release delivery device. The current application (claims 1,4,7-12, 23 and 28-33) and a method of making a controlled release pharmaceutical composition (claims 1-28) in the patented claims. The current application claims anticipate the patented claims

As to the patented claims 1-28, these claims refer to a method of making the controlled release drug using a microbial polysaccharide and cellulose which are obvious variation of the instant claims compositions. The method of making would have resulted in the formation of a controlled release pharmaceutical composition in the patented claims. Thus, the process of making a composition are a set of precursor steps leading to a controlled release formulation and therefore are part of the obvious variation of the patented claims compared to the current application claims.

In view of the foregoing, the patented claims and the current application claims are obvious variations.

Response to arguments under 35 USC § 103

Claims 1,4,7-12 and 28-33 under 35 USC § 103(a) over Guley et al., (US 4,309,405) in view of Jain et al., (US 4,610,870) is withdrawn.

Based on the argument and the submission of the affidavit together with the unexpected result therein, the rejection is withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley V. Gembel whose telephone number is 571-272-8504. The examiner can normally be reached on 8:30 -5:00, Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SVG
12/01/05


ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER